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ART UNIT	PAPER NUMBER
2172	14

DATE MAILED: 01/26/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/552,131	MELKOTE ET AL.	
	Examiner	Art Unit	
	Anh Ly	2172	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *12 December 2003*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-41* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-41* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. §§ 119 and 120

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

13)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

a) ☐ The translation of the foreign language provisional application has been received.

14)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____.
4) ☐ Interview Summary (PTO-413) Paper No(s). _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: .

DETAILED ACTION

Response to Arguments

1. Applicant's arguments filed on 12/12/2003 have been fully considered but they are not persuasive.

Applicant argued that, "Although a central location or library and database is discloses, no teaching or suggestion is provided in Rivette reference after each of the plurality of selected information portions are entered, storing each of the information portions in a central storage location." (page 11, lines 14-17).

Rivette teaches for extracting or retrieving, synchronizing, displaying and manipulating text documents and image documents in machine-readable form for display. That is, the patent documents are stored on storage device or library and automatic pagination (col. 3, lines 28-40, col. 10, lines 25-28, col. 17, lines 65-67 and col. 18, lines 1-67 and col. 34, lines 55-67). Thus, the text documents or patent documents entered by user are stored by user or automatically saved by the system as user logoff the application.

Applicant argued that, "can find no teaching or suggestion for a user entering identification information to retrieve user information based on the identification to create at least a portion of the invention discloses." (page 12, the last paragraph).

Watanabe teach the information or IP information is retrieved by keyword such as identification information of a record (col. 55-63, col. 11, lines 20-28 and col. 15, lines 25-38; also see col. 19, lines 1-4) .

Thus, the applicant's arguments are not persuasive based on the prior arts of record.

2. Claims 1-41 are pending in this application.

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

4. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

5. Claims 1-3, 7, 9, 17-18, 21-23, 37-38 and 41 are rejected under 35 U.S.C. 103(a) as being unpatentable over US Patent No. 6,157,947 issued to Watanabe et al.

(hereinafter Watanabe) in view of US Patent No. 5,991,780 issued to Rivette et al. (hereinafter Rivette).

With respect to claim 1, Watanabe discloses forming an invention disclosure online by entering a plurality of selected information portions into a web-based system (an intellectual property is form via Internet or web-based system in order to distribute to the users of the system: col. 15, lines 27-38 and lines 50-67 and col. 16, lines 1-12 and col. 5, lines 20-54 and col. 6, lines 41-49); and allowing access to various users for reviewing the information (the result is displayed to the user: col. 15, lines 32-38 and lines 42-57; also see abstract, disclosure extents and piece of intellectual property and memory portion: col. 1, lines 8-14 and lines 38-67 and col. 2, lines 10-38; also see Internet or web-based system; col. 3, lines 20-54; figs. 15 and 16).

Watanabe discloses an intellectual property database is formed and distributed via Internet or web-based system (see fig. 3 and col. 5, lines 20-54) and displayed the result for the user via display screen (col. 6, lines 41-49, col. 15, lines 27-38, lines 50-67 and col. 16, lines 1-11). Watanabe discloses the entered intellectual property is stored in the server for users to retrieve (see fig. 6, item S12 and fig. 19, item S65, col. 6, lines 46-55 and col. 17, lines 65-67). Watanabe does not explicitly indicate after each of the plurality of selected information portions are entered, storing each of the information portions in a central storage location.

However, Rivette discloses the finished patents are stored in the primary library (see fig. 1, items 30 and col. 11, lines 29-31).

Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to combine the teachings of Watanabe with the teachings of Rivette so as to obtain a finished patents library where entered or registered patents or intellectual properties are stored as a central storage ,location (col. 11, lines 29-31). This combination would have made the method for automatically distributing, retrieving, and displaying the intellectual properties, which are stored in the central storage library over an invention disclose in an on-line system via Internet.

With respect to claims 2-3, Watanabe discloses step of forming includes providing identification information; whereby upon providing identification information to said web-based server; and retrieving user information from the directory system in response to the identification information (Internet, firewall: see figs 3 and 5, col. 20-54; user ID and password: col. 18, lines 35-61); and step of prompting the user for classification information (category information interpreting as classification information: see table 8-10 and col. 13, lines 1-67 and col. 14, lines 1-65; also see Intellectual Property (IP) ID: col. 11, lines 20-67 and col. 12, lines 1-67).

With respect to claims 7 and 9, Watanabe discloses ranking the disclosure; and prompting a patentability review from the patent staff person (col. 11, lines 20-67 and col. 12, lines 1-67; and col. 2, lines 1-39).

Claim 17 is essentially the same as claim 1 except that it is directed to a system rather than a method ('947 of an intellectual property is form via Internet or web-based system in order to distribute to the users of the system: col. 15, lines 27-38 and lines 50-67 and col. 16, lines 1-12 and col. 5, lines 20-54 and col. 6, lines 41-49; the result is

displayed to the user: col. 15, lines 32-38 and lines 42-57; also see abstract, disclosure extents and piece of intellectual property and memory portion: col. 1, lines 8-14 and lines 38-67 and col. 2, lines 10-38; also see Internet or web-based system; col. 3, lines 20-54; figs. 15 and 16; and '780 of see fig. 1, items 30 and col. 11, lines 29-31), and is rejected for the same reason as applied to the claim 1 hereinabove.

Claim 18 is essentially the same as claim 2 except that it is directed to a system rather than a method (user ID and password: col. 18, lines 35-61), and is rejected for the same reason as applied to the claim 2 hereinabove.

With respect to claims 21-22, Watanabe discloses user computer comprises a CAD file viewer (col. 10, lines 10-40 and col.12, lines 30-60); and wherein said server comprises a web single login (col. 18, lines 35-61).

With respect to claim 23, Watanabe discloses forming an invention disclosure online by entering a plurality of selected information into a web-based system; after each of the plurality of selected information is entered, allowing access to various users to access the information; prompting the user for classification information (an intellectual property is form via Internet or web-based system in order to distribute to the users of the system: col. 15, lines 27-38 and lines 50-67 and col. 16, lines 1-12 and col. 5, lines 20-54 and col. 6, lines 41-49; the result is displayed to the user: col. 15, lines 32-38 and lines 42-57; also see abstract, disclosure extents and piece of intellectual property and memory portion: col. 1, lines 8-14 and lines 38-67 and col. 2, lines 10-38; also see Internet or web-based system; col. 3, lines 20-54; figs. 15 and 16; abstract, disclosure extents and piece of intellectual property and memory portion: col. 1, lines 8-

14 and lines 38-67 and col. 2, lines 10-38; also see Internet or web-based system; col. 3, lines 20-54; col. 15, lines 24-58 and figs. 15 and 16; category information interpreting as classification information: see table 8-10 and col. 13, lines 1-67 and col. 14, lines 1-65; also see Intellectual Property (IP) ID: col. 11, lines 20-67 and col. 12, lines 1-67).

Watanabe discloses an intellectual property database is formed and distributed via Internet or web-based system (see fig. 3 and col. 5, lines 20-54) and displayed the result for the user via display screen (col. 6, lines 41-49, col. 15, lines 27-38, lines 50-67 and col. 16, lines 1-11). Watanabe discloses the entered intellectual property is stored in the server for users to retrieve (see fig. 6, item S12 and fig. 19, item S65, col. 6, lines 46-55 and col. 17, lines 65-67). Watanabe does not explicitly indicate after each of the plurality of selected information portions are entered, storing each of the information portions in a central storage location; notifying an evaluator and prompting an evaluation.

However, Rivette discloses the finished patents are stored in the primary library (see fig. 1, items 30 and col. 11, lines 29-31) and graphical user interface screen from which the user enabling to enter information to retrieve or update information as needed (see abstract, col. 4, lines 12-67 and col. 5, lines 1-10; also see figs 17, 19, 22..); response signals to the users (col. 4, lines 35-50 and col. 11, lines 1-12).

Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to combine the teachings of Watanabe with the teachings of Rivette so as to obtain a finished patents library where entered or registered patents or intellectual properties are stored as a central storage ,location (col.

11, lines 29-31). This combination would have made the method for automatically distributing, retrieving, and displaying the intellectual properties, which are stored in the central storage library over an invention disclose in an on-line system via Internet.

With respect to claim 37, Watanabe disclose entering identification information retrieving user information from a directory system in response to said identification information entering disclosure information to create an invention disclosure; coupling said user information with said disclosure (an intellectual property is form via Internet or web-based system in order to distribute to the users of the system: col. 15, lines 27-38 and lines 50-67 and col. 16, lines 1-12 and col. 5, lines 20-54 and col. 6, lines 41-49; the result is displayed to the user: col. 15, lines 32-38 and lines 42-57see abstract, col. 1, lines 8-14 and lines 38-67, col. 2, lines 1-39; IP database: see fig. 10 item 22 and 32 the portion of IP information is stored in the IP database in order to transfer to the request server , col. 7, lines 38-56).

Watanabe discloses an intellectual property database is formed and distributed via Internet or web-based system (see fig. 3 and col. 5, lines 20-54) and displayed the result for the user via display screen (col. 6, lines 41-49, col. 15, lines 27-38, lines 50-67 and col. 16, lines 1-11). Watanabe discloses the entered intellectual property is stored in the server for users to retrieve (see fig. 6, item S12 and fig. 19, item S65, col. 6, lines 46-55 and col. 17, lines 65-67). Watanabe does not explicitly indicate storing the disclosure in a database.

However, Rivette discloses the finished patents are stored in the database (see fig. 1, items 30 and col. 11, lines 29-31).

Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to combine the teachings of Watanabe with the teachings of Rivette so as to obtain a finished patents library where entered or registered patents or intellectual properties are stored as a central storage ,location (col. 11, lines 29-31). This combination would have made the method for automatically distributing, retrieving, and displaying the intellectual properties, which are stored in the central storage library over an invention disclose in an on-line system via Internet.

With respect to claim 38 and 41, Watanabe discloses prompting the user for classification information; and prompting a patentability review from the patent staff person (col. 11, lines 20-67 and col. 12, lines 1-67; col. 12, lines 1-67; and col. 2, lines 1-39).

6. Claims 4-6, 8, 10-15, 19-20, 24-35, and 39-40 are rejected under 35 U.S.C. 103(a) as being unpatentable over US Patent No. 6,157,947 issued to Watanabe et al. (hereinafter Watanabe) in view of US Patent No. 5,991,780 issued to Rivette et al. (hereinafter Rivette) and further in view of US Patent No. 5,987,464 issued to Schneider.

With respect to claims 4-6 and 8, Watanabe in view of Rivette discloses a method of forming an on-line invention disclosure as discussed in claim 1.

Watanabe and Rivette in combination disclose an intellectual property database is formed and distributed via Internet or web-based system (see fig. 3 and col. 5, lines

20-54) and displayed the result for the user via display screen (Watanabe - col. 6, lines 41-49, col. 15, lines 27-38, lines 50-67 and col. 16, lines 1-11) and entered patents are stored in a central storage library (see fig. 1, items 30 and col. 11, lines 29-31). Watanabe in view of Rivette does not explicitly indicate notifying an evaluator in response to the classification information; prompting an evaluation from the evaluator; generating an E-mail; providing a hyperlink to the disclosure in the E-mail; notifying a patent staff person in response to the classification information; prompting an evaluation comprises scheduling an evaluation meeting.

However, Schneider discloses notifying to the user via e-mail, and hyperlink, and scheduler as claimed (col. 1, lines 15-26, col. 4, lines 62-67, col. 5, lines 1-9, col. 6, lines 8-25, col. 7, lines 26-45, col. 10, lines 12-49 and col. 12, lines 1-33; col. 18, lines 40-67 and col. 19, lines 1-8).

Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to combine the teachings of Watanabe in view of Rivette with the teachings of Schneider so as to have notification via e-mail and hyperlink. This combination would have made the method enabling to connect to the Internet or other on-line services via the transceiver of the computer system from the users can obtain the e-mail as well as the scheduler (Schneider – col. 6, lines 8-24 and col. 11, lines 65-67 and col. 12, lines 1-32) and automatically distributing, retrieving, and displaying the intellectual properties, which are stored in the central storage library over an invention disclose in an on-line system via Internet.

With respect to claims 10-15, Watanabe in view of Rivette discloses a method of forming an on-line invention disclosure as discussed in claim 1. Also Watanabe discloses displaying and user ID and password as claimed (col. 2, lines 1-39 and col. 18, lines 35-61) database server (see fig. 4 and fig. 10).

Watanabe and Rivette in combination disclose an intellectual property database is formed and distributed via Internet or web-based system (see fig. 3 and col. 5, lines 20-54) and displayed the result for the user via display screen (Watanabe - col. 6, lines 41-49, col. 15, lines 27-38, lines 50-67 and col. 16, lines 1-11) and entered patents are stored in a central storage library (see fig. 1, items 30 and col. 11, lines 29-31). Watanabe in view of Rivette does not explicitly indicate notifying co-authors of a disclosure with their name associated therewith in the system; notifying comprises the step of generating an E-mail having a hyperlink therein; providing a status update via E-mail.

However, Schneider discloses notifying to the user via e-mail, hyperlink as claimed (see fig. 11, col. 3, lines 59-67, col. 4, lines 1-8, col. 10, lines 12-49, col. 15, lines 52-67, col. 16, lines 1-33).

Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to combine the teachings of Watanabe in view of Rivette with the teachings of Schneider so as to have notification via e-mail and hyperlink. This combination would have made the method enabling to connect to the Internet or other on-line services via the transceiver of the computer system from the users can obtain the e-mail as well as the scheduler (Schneider – col. 6, lines 8-24 and

col. 11, lines 65-67 and col. 12, lines 1-32) and automatically distributing, retrieving, and displaying the intellectual properties, which are stored in the central storage library over an invention disclose in an on-line system via Internet.

With respect to claims 19-20, Watanabe in view of Rivette discloses a system of forming an on-line invention disclosure as discussed in claim 17.

Watanabe and Rivette in combination disclose an intellectual property database is formed and distributed via Internet or web-based system (see fig. 3 and col. 5, lines 20-54) and displayed the result for the user via display screen (Watanabe - col. 6, lines 41-49, col. 15, lines 27-38, lines 50-67 and col. 16, lines 1-11) and entered patents are stored in a central storage library (see fig. 1, items 30 and col. 11, lines 29-31). Watanabe in view of Rivette does not explicitly indicate wherein said server comprises a web server and a web browser.

However, Schneider discloses web server and web browser as claimed (see fig. 11, col. 15, lines 52-67 and col. 16, lines 1-33).

Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to combine the teachings of Watanabe in view of Rivette with the teachings of Schneider so as to have on-line database to search such as requesting a patent search at the provider's search page on the Internet (Schneider – col. 15, lines 60-67 and col. 16, lines 1-20). This combination would have made the method enabling to connect to the Internet or other on-line services via the transceiver of the computer system from the users can obtain a patent search in the Internet (Schneider – col. 6, lines 8-24 and col. 11, lines 65-67 and col. 12, lines 1-32 and col.

16, lines 1-10) and automatically distributing, retrieving, and displaying the intellectual properties, which are stored in the central storage library over an invention disclose in an on-line system via Internet.

With respect to claim 24, Watanabe discloses forming includes providing identification information; whereby upon providing identification information to said web-based server, retrieving user information from the directory system in response to the identification information (col. 18, lines 35-61; col. 11, lines 20-67 and col. 12, lines 1-67).

With respect to claims 25-29, Watanabe in view of Rivette discloses a system of invention discloses submission as discussed in claim 23. And Watanabe discloses ranking and displaying for review (col. 11, lines 20-67 and col. 12, lines 1-67; and col. 2, lines 1-39).

Watanabe and Rivette in combination disclose an intellectual property database is formed and distributed via Internet or web-based system (see fig. 3 and col. 5, lines 20-54) and displayed the result for the user via display screen (Watanabe - col. 6, lines 41-49, col. 15, lines 27-38, lines 50-67 and col. 16, lines 1-11) and entered patents are stored in a central storage library (see fig. 1, items 30 and col. 11, lines 29-31). Watanabe in view of Rivette does not explicitly indicate notifying comprises the step of generating an E-mail having a hyperlink therein; providing a status update via E-mail, scheduling an evaluation meeting, ranking the disclosure, and notifying a patent staff person.

However, Schneider discloses notifying to the user via e-mail, hyperlink, scheduler (see fig. 11, col. 3, lines 59-67, col. 4, lines 1-8, col. 10, lines 12-49, col. 15, lines 52-67, col. 16, lines 1-33).

Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to combine the teachings of Watanabe in view of Rivette with the teachings of Schneider so as to have notification via e-mail and hyperlink. This combination would have made the method enabling to connect to the Internet or other on-line services via the transceiver of the computer system from the users can obtain the e-mail as well as the scheduler (Schneider – col. 6, lines 8-24 and col. 11, lines 65-67 and col. 12, lines 1-32) and automatically distributing, retrieving, and displaying the intellectual properties, which are stored in the central storage library over an invention disclose in an on-line system via Internet.

With respect to claim 30-35, Watanabe in view of Rivette discloses a submission invention disclosure system as discussed in claim 23. Also Watanabe discloses displaying and user ID and password as claimed (col. 2, lines 1-39 and col. 18, lines 35-61).

Watanabe and Rivette in combination disclose an intellectual property database is formed and distributed via Internet or web-based system (see fig. 3 and col. 5, lines 20-54) and displayed the result for the user via display screen (Watanabe - col. 6, lines 41-49, col. 15, lines 27-38, lines 50-67 and col. 16, lines 1-11) and entered patents are stored in a central storage library (see fig. 1, items 30 and col. 11, lines 29-31). Watanabe in view of Rivette does not explicitly indicate identifying co-authors; notifying

co-authors of a disclosure with their name associated therewith in the system; notifying comprises the step of generating an E-mail having a hyperlink therein; viewing the status of the invention disclosure on-line; providing a status update via E-mail.

However, Schneider discloses database connecting with web server, notifying to the user via e-mail, hyperlink as claimed (see fig. 11, col. 3, lines 59-67, col. 4, lines 1-8, col. 10, lines 12-49, col. 15, lines 52-67, col. 16, lines 1-33).

Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to combine the teachings of Watanabe in view of Rivette with the teachings of Schneider so as to have notification via e-mail and hyperlink. This combination would have made the method enabling to connect to the Internet or other on-line services via the transceiver of the computer system from the users can obtain the e-mail as well as the scheduler (Schneider – col. 6, lines 8-24 and col. 11, lines 65-67 and col. 12, lines 1-32) and automatically distributing, retrieving, and displaying the intellectual properties, which are stored in the central storage library over an invention disclose in an on-line system via Internet.

With respect to claim 39-40, Watanabe in view of Rivette discloses a method of submitting documents as discussed in claim 37.

Watanabe and Rivette in combination disclose an intellectual property database is formed and distributed via Internet or web-based system (see fig. 3 and col. 5, lines 20-54) and displayed the result for the user via display screen (Watanabe - col. 6, lines 41-49, col. 15, lines 27-38, lines 50-67 and col. 16, lines 1-11) and entered patents are stored in a central storage library (see fig. 1, items 30 and col. 11, lines 29-31).

Watanabe in view of Rivette does not explicitly indicate notifying an evaluator in response to the classification information; prompting an evaluation from the evaluator; and notifying a patent staff person in response to the classification information.

However, Schneider discloses notifying an evaluator and notifying to a patent staff as claimed (col. 1, lines 15-26, col. 4, lines 62-67, col. 5, lines 1-9, col. 6, lines 8-25, col. 7, lines 26-45, col. 10, lines 12-49 and col. 12, lines 1-33; col. 18, lines 40-67 and col. 19, lines 1-8).

Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to combine the teachings of Watanabe in view of Rivette with the teachings of Schneider so as to have notification via e-mail and hyperlink. This combination would have made the method enabling to connect to the Internet or other on-line services via the transceiver of the computer system from the users can obtain the e-mail as well as the scheduler (Schneider – col. 6, lines 8-24 and col. 11, lines 65-67 and col. 12, lines 1-32) and automatically distributing, retrieving, and displaying the intellectual properties, which are stored in the central storage library over an invention disclose in an on-line system via Internet.

7. Claims 16 and 36 are rejected under 35 U.S.C. 103(a) as being unpatentable over US Patent No. 6,157,947 issued to Watanabe et al. (hereinafter Watanabe)) in view of US Patent No. 5,991,780 issued to Rivette et al. (hereinafter Rivette) and further in view of US Patent No. 5,329,447 issued to Leedom, Jr. (hereinafter Leedom).

With respect to claim 16, Watanabe in view of Rivette discloses a method of forming an on-line invention disclosure as discussed in claim 1.

Watanabe and Rivette in combination disclose an intellectual property database is formed and distributed via Internet or web-based system (see fig. 3 and col. 5, lines 20-54) and displayed the result for the user via display screen (Watanabe - col. 6, lines 41-49, col. 15, lines 27-38, lines 50-67 and col. 16, lines 1-11) and entered patents are stored in a central storage library (see fig. 1, items 30 and col. 11, lines 29-31). Watanabe in view of Rivette does not explicitly indicate accepting a paper submission; and wherein the step of forming comprises scanning said paper submission into the database.

However, Leedom discloses paper associated with law case and scanning system as claimed (col. 4, lines 52-67, col. 5, lines 1-12, col. 10, lines 8-34 and col. 15, lines 21-56).

Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to combine the teachings of Watanabe in view of Rivette with the teachings of Leedom so as to have a hard copy of papers in the system (col. 4, lines 62-67 and col. 5, lines 1-12). This combination would have made the method having a way to get hard copy of papers from the system (Leedom – col. 10, lines 8-30), and automatically distributing, retrieving, and displaying the intellectual properties, which are stored in the central storage library over an invention disclose in an on-line system via Internet.

With respect to claim 36, Watanabe in view of Rivette discloses a method of forming an on-line invention disclosure as discussed in claim 23.

Watanabe and Rivette in combination disclose an intellectual property database is formed and distributed via Internet or web-based system (see fig. 3 and col. 5, lines 20-54) and displayed the result for the user via display screen (Watanabe - col. 6, lines 41-49, col. 15, lines 27-38, lines 50-67 and col. 16, lines 1-11) and entered patents are stored in a central storage library (see fig. 1, items 30 and col. 11, lines 29-31). Watanabe in view of Rivette does not explicitly indicate accepting a paper submission; and wherein the step of forming comprises scanning said paper submission into the database.

However, Leedom discloses paper associated with law case and scanning system as claimed (col. 4, lines 52-67, col. 5, lines 1-12, col. 10, lines 8-34 and col. 15, lines 21-56).

Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to combine the teachings of Watanabe in view of Rivette with the teachings of Leedom so as to have a hard copy of papers in the system (col. 4, lines 62-67 and col. 5, lines 1-12). This combination would have made the method having a way to get hard copy of papers from the system (Leedom – col. 10, lines 8-30), and automatically distributing, retrieving, and displaying the intellectual properties, which are stored in the central storage library over an invention disclose in an on-line system via Internet.

Conclusion

8. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Contact Information

9. Any inquiry concerning this communication should be directed to Anh Ly whose telephone number is (703) 306-4527 or via E-Mail: **ANH.LY@USPTO.GOV**. The examiner can be reached on Monday - Friday from 8:00 AM to 4:00 PM.

If attempts to reach the examiner are unsuccessful, see the examiner's supervisor, John Breene, can be reached on (703) 305-9790.

Any response to this action should be mailed to:

Commissioner of Patents and Trademarks

Washington, D.C. 20231

or faxed to: (703) 872-9306 (Central Official Fax Number)

Hand-delivered responses should be brought to Crystal Park II, 2121 Crystal Drive, Arlington, VA, Fourth Floor (receptionist).

Inquiries of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 305-3900.

AL
JAN. 20th, 2004

JEAN M. CORRIELUS
PRIMARY EXAMINER